

REMARKS

Claims 1-11, 19-24, and 29 were pending in the above-identified application when last examined. In the Office Action dated December 15, 2008, claims 8-11 were allowed, claims 6 and 7 were objected to, and claims 1-5, 19-24, and 29 were rejected. The rejection was made final. Pursuant to 37 C.F.R. § 1.116(b)(1), Applicants request entry of the above-amendment to amend claims 1 and 19 to comply with a requirement of form expressly set forth in the Final Office Action. For the following reason, Applicants request reconsideration and withdrawal of the Final Rejection and allowance of the present application, including claims 1-11, 19-24, and 29.

Claims 1-7 and 19-21 were objected to as containing informalities. In particular, the language regarding the first, second, and third verification parameters recited in claims 1 and 19 was indicated as being unclear. In response, the requested amendment of claims 1 and 19 spells out a product for each of the verification parameters. In view of these amendments, Applicants request reconsideration and withdrawal of the objection to claims 1-7 and 19-21.

Claims 22-24 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejection.

Independent claim 22 is an apparatus claim containing elements that are expressed using mean-plus-function language. The Final Office Action in the paragraph bridging pages 3 and 4 indicates, “according to the specification (please see Par 0069 and 0117), all of the claimed “means for” can be optionally implemented in computer program or software alone.” Paragraph [0069] of Applicants’ specification states, “The present invention also encompasses apparatus and computer program products both for providing verification parameters enabling verification of an association between two parties, and for carrying out a verification check using these parameters.” Thus, Applicants’ specification in paragraph [0069] refers to a “computer program product,” not to a computer program per se. Applicants contend that in the context of paragraph [0069], “computer program product” inherently indicates utility and functionality and not simply an abstract listing or program. A “computer program product” as described in Applicants’ specification is thus statutorily patentable subject matter under 35 U.S.C. § 101. Paragraph [0117] of Applicants’ specification states, “The first, second, third and fourth computer entities 10, 20, 30, 40 are conventional program-controlled computing

devices though specialised hardware may be provided to effect particular cryptographic processes.” Paragraph [0117] thus refers to “program-controlled computing devices” and specialized hardware, both of which are clearly statutory subject matter under 35 U.S.C. § 101. Accordingly, interpreting the means-plus-function elements of claim 22 as including the elements described in paragraphs [0069] and [0117] does not cause claim 22 to cover non-statutory subject matter.

Applicants further submit that that the recited elements of claim 22 preclude interpretation of those elements as being a nonstatutory “computer program.” For example, claim 22 recites, “means for receiving both data indicative of the first element, and a first product formed by the first party from a first secret and the first element.” The means claim language requires functionality. A computer program as merely a list of instructions is nonstatutory for lack of functionality or utility. For example, MPEP 2106.1 states, “Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.” The “means for” language of claim 22 requires the ability to realize the computer program’s function and thus similarly precludes an interpretation that includes a non-functional computer program.

For the above reasons, claim 22 claims statutory subject matter.

Claims 23 and 24 depend from claim 22 and therefore inherit the statutory subject matter of claim 22.

For the above reasons, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. § 101.

Claims 1-5, 19-21, and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. App. Pub. No. 2003/0182554 (Gentry ‘554) in view of U.S. Pat. App. Pub. No. 2003/0081785 (Boneh) and further in view of U.S. Pat. App. Pub. No. 2003/0179885 (Gentry ‘885). Applicants respectfully traverse the rejection.

Gentry ‘554 and Gentry ‘885 both have the priority date of March 21, 2002, based on priority claims to U.S. Provisional Pat. App. Nos. 60/366,292 and 60/366,196. However, Applicants’ invention of the subject matter now being claimed was before March 21, 2002, so that Gentry ‘554 and Gentry ‘885 are not prior to Applicants’ invention. An accompanying declaration of Inventors, Liqun Chen, Keith A. Harrison, and David Soldera, and a copy of an

“Invention Proposal,” which was created and dated before March 21, 2002 are being submitted to prove prior invention by Applicants. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 103 because Gentry ‘554 and Gentry ‘885 are not available as prior art for the rejection.

Applicants still submit that claims 1-5, 19-21, and 29 patentably distinguish over the combination of Gentry ‘554, Boneh, and Gentry ‘885 for the reasons set forth in Applicants’ reply to the prior Office Action.

For the above reasons, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Claims 6 and 7 were objected to as dependent upon a rejected claim but were indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6 and 7 remain dependent from claim 1, but for the reasons given above, claim 1 is believed patentable. Accordingly, Applicants request reconsideration and withdrawal of the objection to claims 6 and 7.

In summary, claims 1-11, 19-24, and 29 were pending in the application. Amendment of claims 1 and 19 is requested to address matters of form raised in the Final Office Action. For the above reasons, Applicants respectfully request entry of the above amendment, withdrawal of the final rejection, and allowance of the application including claims 1-11, 19-24, and 29. Please contact the undersigned attorney at (530) 621-4545 if there are any questions concerning the application or this document.

Respectfully submitted,

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